

### **REMARKS**

The Final Office Action mailed December 10, has been received and reviewed. Each of claims 1-22 are pending. It is proposed that each of claims 1, 11 and 18 be amended as herein above set forth. It is respectfully submitted that no new matter has been added by way of the proposed amendments. Support for the amendments may be found in the Specification for instance at ¶¶ [0011], [0014], [0042], [0045]-[0048], and [0055]. Reconsideration of the above-identified application in view of the above amendments and the following remarks is respectfully requested.

#### **Examiner Interview**

Applicants would like to thank Examiner Bitar for granting the telephonic interview on February 27, 2008. Examiner indicated that a linear array of gradient indexed lenses is not disclosed by the references, but additional searching may be required.

#### **Provisional Non-statutory Double Patenting Rejection**

Claims 1-22 are provisionally rejected on the grounds of non-statutory double patenting over claims 1-15 and 21 of U.S. Patent Application No. 10/722631. Without conceding the propriety of the rejections of claims 1-22, Applicants will consider filing a terminal disclaimer to obviate these rejections when the present application is otherwise in condition for allowance.

## **Rejections based on 35 U.S.C. § 102**

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdeggal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 19133, 1920 (Fed. Cir. 1989); *see also*, MPEP § 2131.

Claims 1-4 and 11-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,942,761 to Tuli et al. (hereinafter the “Tuli reference”). As the Tuli reference does not describe, either expressly or inherently, each and every element of the rejected claims, Applicants respectfully traverse the rejection as hereinafter set forth.

Independent claim 1 recites a an input device for scanning a biometric image. The input device comprises a housing; a *scan head movably mounted* to the housing wherein the scan head is comprised of at least a *light source and a linear array of gradient indexed lenses*; a platen moveably mounted to the housing and the scan head for movement relative to the housing and the scan head between a first position and a second position; a biasing device configured to bias the platen toward the first position; a *start of scan switch* located such that the start of scan switch is activated when the platen moves in a downward translation from the first position; and an *end of scan switch* located such that the end of scan switch is activated when the platen is at the second position.

The Tuli reference describes a fingerprint reading device. *See Tuli reference* at Abstract. The Final Office Action states that, if the claims were read broadly, the scan head could be the platen head of Tuli because a sensor or light is not claimed as part of the moveable scan head. *See Final Office Action* p.2, ¶5. The proposed amendments to independent claim 1 recites, among other things, a scan head that is moveably mounted to the housing, wherein the scan head is comprised of at least a light source and a linear array of gradient indexed lenses. It is respectfully submitted that even when read broadly, the scan head, which is moveable, includes a light source. And therefore the scan head could not also be the platen head as described by Tuli.

Additionally, the proposed amendments to independent claim 1 recites, in part, a start of scan switch located such that the start of scan switch is activated when the platen moves in a downward translation from the first position; and an end of scan switch located such that the end of scan switch is activated when the platen is at the second position. It is respectfully submitted that the Tuli reference fails to teach and suggest a start switch that is activated when a platen moves in a downward translation from a first position, nor does the Tuli reference disclose an end of scan switch that is activated when the platen is moved to a second position. *See generally Tuli reference.*

Accordingly, it is respectfully submitted that the Tuli reference fails to describe, either expressly or inherently, each and every element of independent claim 1. Moreover, the Tuli reference fails to show the identical invention in as complete detail as contained in the claim. Thus, it is respectfully submitted that the proposed claim 1 is not anticipated by the Tuli reference. Therefore, withdrawal of the 35 U.S.C. §102(b) rejection of claim 1 is respectfully requested.

Each of claims 2-4 depends, either directly, or indirectly, from amended independent claim 1. As such it is respectfully submitted that the Tuli reference fails to describe, either expressly or inherently, each and every element of these claims for at least the above-cited reasons. Accordingly, withdrawal of the 35 U.S.C. §102(b) rejection of claims 2-4 is respectfully requested.

Independent claim 11 recites an input device for scanning a biometric image. The input device comprised of a housing having an *angled way*; a platen moveably mounted to the housing for movement between a first position and a second position, the platen being adaptive to receive the biometric image; a scan head, comprised of at least a light source and a *linear array of gradient indexed lenses, moveably mounted to the angled way*, wherein movement of the platen causes the scan head to translate along the angled way; and an encoder target.

It is respectfully submitted that the Tuli reference fails to describe an *angled way* with a *scan head moveably mounted to the angled way*. As previously discussed, the Final Office Action states that, if the claims are interpreted broadly, the scan head could also be the platen head because the claim does not require the scan head to be comprised of at least a light source. *See Final Office Action* at p. 2, ¶ 5. The proposed amendments to independent claim 11 recite, in part, a scan head the is comprised of at least a light source and a linear array of gradient indexed lenses. It is respectfully submitted, that a scan head that is comprised of at least a light source and a linear array of gradient indexed lenses is not described, explicitly or inherently, by the platen of the Tuli reference. Therefore, the Tuli reference does not describe a scan head moveably mounted.

Additionally, it is respectfully submitted that the Tuli reference fails to describe an angled way to which the scan head is moveably mounted. *See generally Tuli reference*. The

structure, an angled way, that allows for the translation of a platen's vertical force into movement of a scan head is not described in the Tuli reference. *Id.*

Accordingly, it is respectfully submitted that the Tuli reference fails to describe, either expressly or inherently, each and every element of independent claim 11. Moreover, the Tuli reference fails to show the identical invention in as complete detail as contained in the claim. Thus, it is respectfully that claim 11, as proposed, is not anticipated by the Tuli reference. Therefore, withdrawal of the 35 U.S.C. §102(b) rejection of claim 11 is respectfully requested.

Each of claims 12-17 depends, either directly, or indirectly, from amended independent claim 11. As such it is respectfully submitted that the Tuli reference fails to describe, either expressly or inherently, each and every element of these claims for at least the above-cited reasons. Accordingly, withdrawal of the 35 U.S.C. §102(b) rejection of claims 12-17 is respectfully requested.

Independent claim 18 recites an input device for scanning a biometric image. The input device comprising a housing having an *angled way* a platen moveably mounted to the housing, an encoder target associated with the platen; and a *scan head, comprised of at least a light source and a linear array of gradient indexed lenses, moveably mounted to the angled way*, wherein movement of the platen causes the scan head to traverse the platen, the scan head configured, in operation, to capture a scan line of the fingerprint image and a portion of a pattern on the encoder target while traversing the platen.

It is respectfully submitted that the Tuli reference fails to describe an *angled way* with a *scan head moveably mounted to the angled way*. As previously discussed, the Final Office Action states that, if the claims are interpreted broadly, the scan head could also be the platen head because the claim does not require the scan head to be comprised of at least a light

source and a linear array of gradient indexed lenses. *See Final Office Action* at p. 2, ¶ 5. The proposed amendments to independent claim 18 recite, in part, a scan head the is comprised of at least a light source. It is respectfully submitted, that a scan head that is comprised of at least a light source and a linear array of gradient indexed lenses is not described, explicitly or inherently, by the platen of the Tuli reference. Therefore, the Tuli reference does not describe a scan head moveably mounted.

Additionally, it is respectfully submitted that the Tuli reference fails to describe an angled way to which the scan head is moveably mounted. *See generally Tuli reference*. The structure, an angled way, that allows for the translation of a platen's vertical force into movement of a scan head is not described in the Tuli reference. *Id.*

Accordingly, it is respectfully submitted that the Tuli reference fails to describe, either expressly or inherently, each and every element of independent claim 18. Moreover, the Tuli reference fails to show the identical invention in as complete detail as contained in the claim. Thus, it is respectfully that claim 18, as proposed, is not anticipated by the Tuli reference. Therefore, withdrawal of the 35 U.S.C. §102(b) rejection of claim 18 is respectfully requested.

Each of claims 19-22 depends, either directly, or indirectly, from amended independent claim 18. As such it is respectfully submitted that the Tuli reference fails to describe, either expressly or inherently, each and every element of these claims for at least the above-cited reasons. Accordingly, withdrawal of the 35 U.S.C. §102(b) rejection of claims 19-22 is respectfully requested.

### **Rejections based on 35 U.S.C. § 103**

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestion or motivation found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See, *Application of Bergel*, 292 F. 2d 955, 956-957 (1961). Thus, in order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP § 2143. Recently, the Supreme Court elaborated, at pages 13-14 of *KSR*, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of]

ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

Claims 5-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the Tuli reference in view of U.S. Patent No. 6,178,255 to Scott et al. (hereinafter the “Scott reference”). Claims 5-10 depends, either directly or indirectly, from independent claim 1. As discussed hereinabove, the Tuli reference fails to describe, as recited in the proposed amendments to independent claim 1, a scan head comprised of at least a light source, wherein the scan head is moveably mounted.

The Scott reference describes a finger print verifier that includes a prism that slides over the imaged area of a camera. *See Scott reference* at Abstract. It is respectfully submitted that the Scott reference fails to teach or suggest a scan head comprised of at least a light source and a linear array of gradient indexed lenses, wherein the scan head is moveably mounted. Instead, the Scott reference teaches the rolling of the fingers to acquire a complete fingerprint instead the movement of a scan head, wherein the scan head is comprised of at least a light source. *See Scott reference* at col. 4, lines 39-42.

Additionally, as discussed hereinabove, the Tuli reference fails to describe a start of scan switch that is activated when a platen moves in a downward translation from a first position and an end of scan switch that is activated when the platen is at a second position. It is respectfully submitted that the Scott reference fails to cure these deficiencies. The Scott reference fails to teach or suggest a first switch that is activated when a platen moves from a first position. Because the Scott reference teaches a rolling or flat print of the fingers, the platen of the Scott reference does not move from a first position to a second position, therefore a start



scan switch could not be activated as included in the proposed claim amendments. *See generally Scott reference.* The same logic applies to the end of scan switch that is activated when the platen is in a second position. Therefore, it is respectfully submitted, that the Scott reference fails to teach or suggest a start of scan switch and an end of scan switch.

Accordingly, it is respectfully submitted that the Tuli reference as modified by the Scott reference is not the equivalent to an input device comprising a housing; a *scan head movably mounted* to the housing wherein the scan head is comprised of at least a light source and a linear array of gradient indexed lenses; a platen moveably mounted to the housing and the scan head for movement relative to the housing and the scan head between a first position and a second position; a biasing device configured to bias the platen toward the first position; a *start of scan switch* located such that the start of scan switch is activated when the platen moves in a downward translation from the first position; and an *end of scan switch* located such that the end of scan switch is activated when the platen is at the second position. Thus Applicants respectfully submit that the Tuli and Scott references, either alone or in combination, fail to teach or suggest all of the limitations of independent claim 1. Therefore a *prima facie* case of obviousness has not been established for independent claim 1. Each of claims 5-10 that depends, either directly or indirectly, from independent claim 1. Thus, Applicants respectfully submit that the Tuli and Scott references, either alone or in combination, fail to teach or suggest all of the limitations of the dependent claims 5-10 for at least the above-cited reasons. Therefore, a *prima facie* case of obviousness has not been established for these claims and, accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection thereof.

## **CONCLUSION**

For the reasons stated above, claims 1-22 are believed to be in condition for allowance. Applicants respectfully request entry of the proposed amendments, withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or cwfisher@shb.com (such communication via email is herein expressly granted) – to resolve the same.

It is believed that no fee is due in conjunction with the present communication. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112 referencing attorney docket number MFCP.139667.

Respectfully submitted,

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